

REMARKS

A. Double Patenting

In the Office Action mailed on June 14, 2004, claim 43 was objected to as being a substantial duplicate of claim 25. Applicants traverse this rejection. In particular, claim 25 recites an information source, a telematics interface and a satellite-air interface while claim 43 recites the following “means-plus-function” elements: 1) “an information source means for providing information connected to said ground station,” 2) “a telematics interface means for providing telematics applications” and 3) “a satellite-air interface means for providing communication between said satellite and said telematics interface means.” It is well known that the scope of a “means-plus-function” element is defined to cover “the corresponding structure . . . described in the specification and equivalents thereof.” 35 U.S.C. § 112, sixth paragraph. Since the scope of the three “means-plus-function” elements of claim 43 is necessarily different and less broad than the three similar elements of claim 25 mentioned above, it follows that the claims are not substantially duplicative of one another and so the objection is improper and should be withdrawn.

B. 35 U.S.C. § 102

1. Claims 25-29 and 31-42

Claims 25-29 and 31-42 were rejected under 35 U.S.C. § 102(e) as being anticipated by Clayton et al. Applicants traverse this rejection for several reasons. First, claims 25 and 29 have been canceled rendering their rejections moot. Regarding the remaining claims, claim 30 has been amended to be in independent form and claims 31, 32 and 39-42 have been amended so that claims 25-29 and 31-42 depend directly or indirectly on claim 30. Since the Office Action has

conceded that Clayton et al. fails to disclose a receiver that has a unique alpha-numeric name associated therewith as recited in claim 30, the rejection of claims 25-29 and 31-42 has been overcome and should be withdrawn.

As mentioned above, claim 30 has been amended so as to be in independent form. Since the amendment does not change the inherent meaning and scope of original claim 30, the amendment is not related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

The amendments of claims 31, 32 and 39-42 are being made to provide additional coverage for the system of claim 30 and so are not related to patentability as defined in *Festo*.

2. Claims 43-50

Claims 43-50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Clayton et al. Applicants traverse this rejection. Independent claim 43 recites a “telematics interface means for providing telematics applications.” As pointed above in Section A, the recited “telematics interface means” is in the form of a means-plus-function element. As mandated by 35 U.S.C. § 112, sixth paragraph, and the Patent Office (MPEP § 2181) a means-plus-function element is limited to covering “the corresponding structure . . . described in the specification and equivalents thereof.” 35 U.S.C. § 112, sixth paragraph. Accordingly, the recited “telematics interface means” covers the telematics interface device 210 described in Applicants’ specification and equivalents thereof. As shown in FIG. 3 of Applicants’ Specification, the telematics interface device 210 includes a receiver device partitioning system 212 with data channel and data service decoders 226 and 228. Clayton et al. fails to disclose a receiving device

partitioning system 212 as shown in FIG. 3 and described on pages 9 and 10 of Applicants' Specification and equivalents thereof. Accordingly, claim 43 is not anticipated by Clayton et al. and the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that Clayton et al. fails to disclose a telematics interface means that includes Applicants' receiver 216 or equivalents thereto that includes an electronic serial number as described on page 14 of Applicants' Specification. As mentioned above in Section B.1., Clayton et al. fails to disclose a receiver that has a unique alpha-numeric name associated therewith. In addition, Clayton et al. fails to use a receiver that uses a unique alpha-numeric name to check if a user of the receiver is a subscriber.

Accordingly, the rejection is improper and should be withdrawn.

The rejection of claim 44 is improper because Clayton et al. fails to disclose a receiver structure that covers the recited receiver 216 of Applicants' Specification and equivalents thereto as noted above.

The rejection of claim 45 is improper because Clayton et al. fails to disclose a transformation system that supports varying hardware platforms.

The rejection of claim 47 is improper because Clayton et al. fails to disclose a receiver device partitioning means that covers the recited receiver device partitioning system 212 and equivalents thereof as mentioned above.

C. 35 U.S.C. § 103

Claim 30 was rejected under 35 U.S.C. § 103 as being obvious in view of Clayton et al. and Osmani et al. Applicants traverse this rejection. As mentioned above in Section B.1, the Office Action has conceded that Clayton et al. fails to disclose claim 30's recited receiver that

has a unique alpha-numeric name associated therewith. The Office Action relies on Osmani et al. as curing the deficiencies of Clayton et al. In particular, the Office Action points to a passage at Col. 17, lines 12-17 of Osmani et al. as suggesting using the claimed receiver in Clayton et al. This reliance is misplaced. The passage in question states:

The generic phone number of the radiotelephone (MIN 1 & 2) along with it's (sic) unique electronic serial number (ESN) are sent to the system [cellular system 100] to process the request for validity. However, in order to initiate this action of requesting a phone call, the radiotelephone must first obtain service. (emphasis added and bracketed material added)

The passage states that the ESN is sent to the system 101. The sending of data strongly indicates that the passage is referring to a transceiver of the radiotelephone and not a receiver of the radiotelephone. Since there is no motivation in either Clayton et al. or Osmani et al. to alter Clayton et al. so that Clayton et al.'s receiver has a unique alpha-numeric name associated therewith, the rejection is improper and should be withdrawn.

D. Claims 1-24 and 51-61

Claims 1-24 and 51-61 have been withdrawn from consideration in view of Applicants' Response to Election/Restriction Requirement filed on July 16, 2003 in which claims 1-24 and 51-61 were not elected. Applicants reserve the right to file claims 1-24 and 51-61 in one or more divisional applications. Accordingly, the cancellation of claims 1-24 and 51-61 is not related to patentability as defined in *Festo*.

E. New Claim 62

New claim 62 depends directly on claims 30 and so is patentable for the same reasons that claim 30 is patentable over Clayton et al. as pointed out above in Section B.1. In addition,

claim 62 is patentable over Clayton et al. since Clayton et al. does not disclose nor suggest having a receiver that uses a unique alpha-numeric name to check if a user of the receiver is a subscriber. Osmani et al. does not cure the deficiencies of Clayton et al. and so claim 62 is patentable over Clayton et al. and Osmani et al.

Claim 62 has been added to provide additional coverage for the system of claim 30 and so is not being made for reasons of patentability as defined in *Festo*.

F. New Claims 63-72

New claim 63 corresponds to original claim 31 written in independent form. As mentioned above, neither Clayton et al. nor Osmani et al. discloses or suggests altering Clayton et al. to use the recited transformation system that supports varying hardware platforms. Without such suggestion, claim 63 and its dependent claims are patentable over Clayton et al. and Osmani et al.

As mentioned above, claim 63 corresponds to original claim 31 in independent form and does not change the inherent meaning and scope of original claim 31. Accordingly, the amendment is not related to patentability as defined in *Festo*. In addition, new claims 64-72 have been added to provide additional coverage for the system of claim 63 (original claim 31) and so are not being made for reasons of patentability as defined in *Festo*.

G. New Claims 73-80

New claim 73 corresponds to original claim 35 written in independent form. As mentioned above, neither Clayton et al. nor Osmani et al. discloses or suggests altering Clayton et al. to use the recited receiver device partitioning system that is connected with a receiver and receives digital data from the receiver and extracts telematics-specific data from the digital data.

As mentioned above, claim 73 corresponds to original claim 35 in independent form and does not change the inherent meaning and scope of original claim 35. Accordingly, the amendment is not related to patentability as defined in *Festo*. In addition, new claims 74-80 have been added to provide additional coverage for the system of claim 73 (original claim 35) and so are not being made for reasons of patentability as defined in *Festo*.

H. New Claims 81-84

New claim 81 generally corresponds to original claim 41 written in independent form and clarifies that pushing the button explicitly indicates a dislike for an item. Neither Clayton et al. nor Osmani et al. discloses or suggests altering Clayton et al. to use the recited button. Accordingly, claim 81 is patentable over Clayton et al. and Osmani et al.

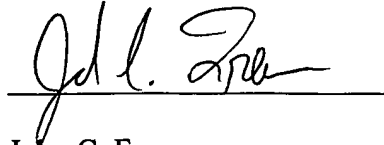
As mentioned above, claim 81 generally corresponds to original claim 41 in independent form. Accordingly, those portions of the amendment that regard subject matter inherently present in original claim 41, they are not related to patentability as defined in *Festo*. In addition, new claims 81-84 have been added to provide additional coverage for the system of claim 81 and so are not being made for reasons of patentability as defined in *Festo*.

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 26-28, 30-50 and 62-84 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office

Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

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FIG. 3

